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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,202	08/02/2001	Ronald Stevens	478.1010	6743

7590 09/17/2004

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EXAMINER
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NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/856,202

Applicant(s)

STEVENS ET AL.

Examiner

Thu Khanh T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The function of the machine does not further describe the structure of the apparatus and does not determine the patentability of apparatus claims.

2. Claim 24 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 12-15, 17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Eddy et al (3,732,056).

Eddy et al teaches a molding apparatus, comprising a pair of upper and lower punches (28, 30), and a tubular die (26) for compacting powder material, wherein the punches and the die are made of stabilized zirconia (col. 2, line 66 – col. 3, line 22).

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5. Claims 1, 12-16, 19-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gulati et al (4,270,380).

Gulati et al teach a metal shaping die assembly, comprising a liner cylindrical die insert (7) made of stabilized zirconia ceramic (col. 3, line 44-46) and another portion, or coating (9), made of lead-zinc-borate compound (col. 3, lines 59-65).

6. Claims 1, 12-15, 17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese reference (61-293410).

The Japanese reference teaches powder molding apparatus, comprising a mold with a metal base (1) and a die (10) and a corresponding punch (7), wherein the die is made of stabilized zirconia and having an annular cylindrical shape (10, abstract).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over The German reference (296 19 564) in view of Feagin (4,196,769).

The German reference teaches a tablet machine, comprising a punch (1) and a corresponding die (1'), wherein the punch includes a body portion (2), an embossing element (3) which could be a protrusion or a recess, and a tip portion (7) and the die having a non-stick

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coating of zirconia bonded to a metal selected from alumina, zirconia and beryllium oxide (see the English abstract).

The German reference, however, fails to disclose that the tablet machine comprising stabilized zirconia.

Feagin discloses a ceramic shell mold, comprising a mold made of alumina and stabilized zirconia because of its high softening temperature (col. 3, lines 25-52), in which the ratio of alumina- stabilized zirconia could be changed depending on the desired properties of the mold (Examples 1-9).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify The German reference by providing the die and the punches made of alumina- stabilized zirconia as taught by Feagin so that the die and the punches could be used at a very high temperature.

In regard to the shape of the embossing indicia on the punch, it would have been obvious to one of ordinary skill in the art to replace them with any desired identify marks. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. See *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23 and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

9. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al (3,732,056) as applied to claims 1-3, 12-15, 17 and 19-24 above, and further in view of the second German reference (298 07 840).

Eddy et al disclose a powder forming press as described above, but fail to disclose that the shaped member having a recess region, a protrusion in the form of the alphabet letter.

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The German reference ('840) discloses a tablet forming machine, comprising a tablet forming tool body (2) having an embossing surface with a recessed region (4") and a protrusion in the form of an alphabet letter (N) for producing an embossed in the forming tablet.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Eddy et al by providing an embossing or recess on the mold surface as taught by the German reference ('840), because the embossing or the recess would form a stamping structure on the tablet surface to create a distinguish mark or for identification purposes.

In regard to claim 10, it is in the scope of a skilled artisan to configure and dimension the embossing means to have very small, microscopic, indentations to form configurations on the product surface such that it would be invisible to the naked eye, if so desired. The size or the shape of a mold structure will not render the apparatus claims patentable over the prior art of record. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

### ***Response to Arguments***

10. Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive.

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The Applicants have argued that the cited prior art are not related to tablet forming machine; thus, they are not anticipate the claims that regard to tablet machine. The prior art, however, is in the general powder press forming art, which also includes the tablet forming area. Each cited reference described a mold, having a die, a punch or both made of stabilized zirconia or Lumina-stabilized zirconia combination– which are newly amended to the claims. The prior art discloses all the claimed structure; therefore, they are anticipating the current claims, or the claims are obvious in view of those cited references. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (Emphasis in original)

It has been held that a functional limitation asserted to be critical for establishing novelty may, in fact, be an inherent characteristic of the prior art. The applicants is required to prove that the subject matter shown in the prior art does not necessarily possess the characteristics relied on. In re Schreiber, 128 F. 3d 1473, 1478, 44 USPQ 2d, 1432 (Fed. Cir. 1997); See also, In re Spada, 911 F 2d 705, 708, 15 USPQ 2d 1655, 1658 (Fed. Cir. 1977); In re Best, 562 F. 2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); and Ex Parte Gray, 10 USPQ 2d 1922, 1925 (Bd. Pat. App. & Int. 1989).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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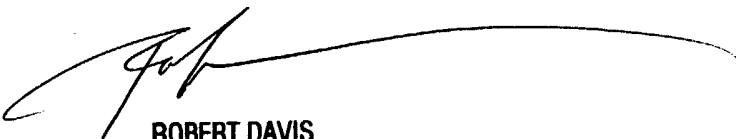
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Khanh T. Nguyen whose telephone number is 571-272-1136. The examiner can normally be reached on Monday- Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L. Utech can be reached on 571-272-1137. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

TN



ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 1300/700

9/15/2007